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APR 11 2005

In re Application of
Stephen J. Benkovic et al.
Application No. 10/615,703
Filed: July 9, 2003
Attorney Docket No. 00-387-P

: **OFFICE OF PETITIONS**
:
: **DECISION REFUSING STATUS**
: **UNDER 37 CFR 1.47(a)**
:

This decision is in response to the petition filed June 21, 2004, under 37 CFR 1.47(a), in response to the Notice to File Missing Parts "Notice" mailed December 15, 2003.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on July 9, 2003, naming Stephen J. Benkovic, Lucy Shapiro, Rachel Wright, Craig Stephens, Lyn Sue Kahng, Anthony Berdis and Irene Lee but without a signed declaration. Accordingly, on December 15, 2003, a "Notice To File Missing Parts of Application" was mailed, requiring *inter alia* a properly executed oath or declaration.

In response, the present petition was filed with a request for a four month extension of time and the oath and declaration signed by inventors Benkovic, Shapiro, Stephens, Kahng, Berdis and Lee only. Petitioners seek status under 37 CFR 1.47(a) based on the fact that mail sent to Ms. Wright's last known address in the United States was returned as "unclaimed" and further that joint inventor Shapiro has indicated that while she doesn't have an address for Ms. Wright, she knows that she is currently living in New Zealand. Petitioner claims that they have diligently sought to locate Ms. Wright but have been unsuccessful.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

The present petition lacks item (1).

The evidence presented is not sufficient to show that Ms. Wright cannot be located, since no proof has been presented to that end. If petitioners are satisfied that Ms. Wright no longer lives at the last known address and would like to renew the argument that Ms. Wright cannot be located, petitioners must present a showing that diligent efforts have been made to locate him.¹ Petitioners must however provide details, in an affidavit or declaration of facts by a person with first hand knowledge of the details, of the additional efforts to locate Ms. Wright such as Internet, e-mail, or telephone directory searches, which have been undertaken to locate her. If repeated attempts to contact Ms. Wright by telephone, mail, and e-mail, are unsuccessful, petitioners will have established that she cannot be found despite diligent efforts.

Additionally, the evidence presented indicates that a copy of the filing receipt for the instant application and a combined declaration and power of attorney were mailed to Ms. Wright but it doesn't indicate that the complete application was ever sent to her. If the non-signing inventor is located, petitioner will want to show proof that a copy of the application was sent or given to the non-signing inventors for review by providing a copy of the cover letter transmitting the application papers to the non-signing inventors or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

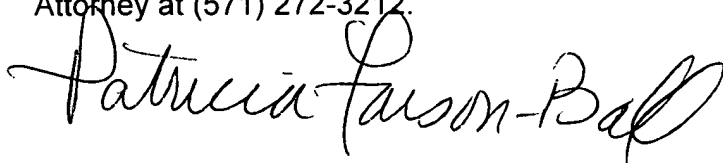
Likewise, before a *bona fide* refusal can be shown, the non-signing inventor must have been given an opportunity to review the application. Therefore, petitioners must show proof that the non-signing inventor refuses to sign the declaration after being sent or given a copy of the application papers. If there is a written refusal, petitioners should submit a copy of that refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.



Patricia Faison-Ball
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Office of Petitions

¹MPEP 409.03(d).